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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,666	02/20/2004	Jan Kall	59643.00379	5521

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EXAMINER	
ADDY, ANTHONY S	

ART UNIT	PAPER NUMBER
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/781,666	KALL ET AL.	
	Examiner	Art Unit	
	Anthony S. Addy	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6,8-15,18 and 20-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3, 6, 8-15, 18 and 20-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's request filed on July 09, 2007 for reconsideration of the finality of the rejection of the last Office action and, therefore, the finality of that action is withdrawn. Prosecution is hereby reopened. New grounds of rejections are set forth below. **Claims 1-3, 6, 8-15, 18** and **20-33** are pending in the present application.

Response to Arguments

2. Applicant's arguments with respect to **claims 1-3, 6, 8-15, 18** and **20-33** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 9, 12, 13, 21, 25-29 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by **Purdy et al., U.S. Patent Number 7,039,411 (hereinafter Purdy)**.

Regarding claims 1, 13, 29 and 33, Purdy discloses a method for controlling sending of messages in a communication system, the method comprising: providing a network entity (*e.g. multimedia call processing server 150*) with restriction information associated with terminating parties in the communication system (see col. 5, lines 6-20 and Fig. 1; shows a multimedia call processing server 150 [*i.e. reads on a network entity*] storing restriction information [*i.e. first and second mobile user record 154 & 155*] associated with terminating parties [*i.e. first and second PID 110 & 120*] in the communication system); determining at least one terminating party (i.e. *first or second PID 110 & 120)* for a message to be sent (see col. 2, lines 64-67, col. 4, lines 29-31 and col. 5, lines 13-20); defining the restriction information associated with the terminating parties to comprise a restriction level for sending the message to the at least one terminating party wherein the terminating parties are classified into a plurality of restriction levels (see col. 5, lines 13-20 [*i.e. the terminating parties are classified into a plurality of restriction levels, such as if a user is authorized to receive a call, how long a mobile user can be provided communications service, etc. For example a mobile user may be authorized to receive a certain number of multimedia calls during a period (e.g., 25 calls per month), a certain number of minutes of multimedia calls per period (e.g., 300 minutes a month), or an unspecified amount (e.g., is billed for minutes actually used*)]); and controlling sending of the message based on the restriction information; wherein the restriction level defines a type of message (*e.g. multimedia message*) which can be received by the at least one terminating party (see col. 5, lines 13-20).

Regarding claims 9 and 21, Purdy teaches all the limitations of claims 1 and 13. In addition, Purdy teaches a system and method, further comprising defining the restriction level for a receiver group address in function of an estimated amount of terminating parties (see col. 10, lines 15-44).

Regarding claim 12, Purdy discloses a computer program, comprising program code means embodied on a computer readable medium (see col. 10, lines 45-61), said computer program controlling a computer to perform a method comprising: providing a network entity (*e.g. multimedia call processing server 150*) with restriction information associated with terminating parties in the communication system (see col. 5, lines 6-20 and Fig. 1; shows a multimedia call processing server 150 [*i.e. reads on a network entity*] storing restriction information [*i.e. first and second mobile user record 154 & 155*] associated with terminating parties [*i.e. first and second PID 110 & 120*] in the communication system); determining at least one terminating party (i.e. *first or second PID 110 & 120)* for a message to be sent (see col. 2, lines 64-67, col. 4, lines 29-31 and col. 5, lines 13-20); defining the restriction information associated with the terminating parties to comprise a restriction level for sending the message to the at least one terminating party wherein the terminating parties are classified into a plurality of restriction levels (see col. 5, lines 13-20 [*i.e. the terminating parties are classified into a plurality of restriction levels, such as if a user is authorized to receive a call, how long a mobile user can be provided communications service, etc. For example a mobile user may be authorized to receive a certain number of multimedia calls during a period (e.g., 25 calls per month), a certain number of*

minutes of multimedia calls per period (e.g., 300 minutes a month), or an unspecified amount (e.g., is billed for minutes actually used)]); and controlling sending of the message based on the restriction information; wherein the restriction level defines a type of message (*e.g. multimedia message*) which can be received by the at least one terminating party (see col. 5, lines 13-20).

Regarding claim 25, Purdy teaches all the limitations of claim 13. In addition, Purdy teaches a system, wherein the network entity is selected from a group comprising at least one of a user equipment, a serving controller, an application server and a subscriber information register (see col. 4, line 58 through col. 5, line 5 and col. 5, line 60 through col. 6, line 4).

Regarding claim 26, Purdy teaches all the limitations of claim 13. In addition, Purdy teaches a system, wherein the network entity comprises an email server, the controlling unit comprises a domain checking function block connected or included in the email server, and the terminating party comprises an email client of a receiver (see col. 4, line 58 through col. 5, line 5 and col. 5, line 60 through col. 6, line 4).

Regarding claim 27, Purdy teaches all the limitations of claim 13. In addition, Purdy teaches a system, wherein the network entity comprises a serving controller in an Internet Protocol Multimedia subsystem, the controlling means is included in an application server communicating with the serving controller, and the terminating party comprises a user equipment connected to the Internet Protocol Multimedia subsystem (see col. 4, line 47 through col. 5, line 5 and col. 5, line 60 through col. 6, line 34).

Regarding claim 28, Purdy teaches all the limitations of claim 13. In addition, Purdy teaches a system, wherein the network entity comprises a multimedia message service server, the controlling means is included in an application server communicating with the multimedia message service server and the terminating party comprises a multimedia message service user agent of a receiver (see col. 4, line 47 through col. 5, line 5 and col. 5, line 60 through col. 6, line 34).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2, 3, 14, 15, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Purdy et al., U.S. Patent Number 7,039,411 (hereinafter Purdy)** as applied to claims 1, 12, 13, 29 and 33 above, and further in view of **Allison et al., U.S. Publication Number 2003/0083078 A1 (hereinafter Allison)**.

Regarding claims 2, 3, 14, 15, 30 and 31, Purdy teaches all the limitations of claims 1, 13 and 29, but fails to explicitly teach a method, wherein the controlling step comprises deciding if the sending of the message is allowed or denied, and when the sending of the message is denied, providing a warning message in response to a sending command.

In an analogous field of endeavor, Allison teaches a method and system for preventing delivery of unwanted short message service (SMS) messages,

wherein, when an SMS message is discarded (i.e. not delivered to the intended addressee) due to the message not wanted by a called or receiving party, a SMS message is generated to notify the sending or calling party associated with the discarded message that delivery of the SMS message was unsuccessful (see p. 1 [0016]).

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to modify Purdy with the teachings of Allison to include a system and method, further comprising, when the sending of the message is denied, providing a warning message in response to a sending command, in order to notify the sending or calling party associated with the discarded message that delivery of the SMS message was unsuccessful as taught by Allison (see p. 1 [0016]).

Claims 6, 8, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Purdy et al., U.S. Patent Number 7,039,411 (hereinafter Purdy)** as applied to claims 1 and 13 above, and further in view of **Molnar et al., U.S. Publication Number 2002/0168978 A1 (hereinafter Molnar)**.

Regarding claims 6, 8, 18 and 20, Purdy teaches all the limitations of claims 1 and 13, but fails to explicitly teach a method and system, wherein defining the restriction level comprises classifying the terminating party as private, confidential or public.

In an analogous field of endeavor, Molnar teaches a method and system, wherein defining the restriction level comprises classifying the terminating parties as private, confidential or public (see p. 3 [0041]).

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to modify Purdy with the teachings of Molnar to include a system and method, wherein defining the restriction level comprises classifying the terminating party as private, confidential or public, in order to facilitate the restriction of a message based on a mobile terminating parties subscriber address, wherein the mobile terminating party subscriber address includes such groups as all subscribers of an operator, or all subscribers having a specific type of subscription like being private subscribers, being employees of a (specific) company or all being members of a family as taught by Molnar (see p. 3 [0041]).

Claims 10, 11, 22-24, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Purdy et al., U.S. Patent Number 7,039,411 (hereinafter Purdy)** and **Allison et al., U.S. Publication Number 2003/0083078 A1 (hereinafter Allison)** as applied to claims 2, 13, 14 and 30 above, and further in view of **Dickinson, III et al., U.S. Publication Number 2003/0196098 A1 (hereinafter Dickinson)**.

Regarding claims 10, 11, 22, 23, 24 and 32, Purdy in view of Allison teaches all the limitations of claims 2, 13, 14 and 30. Purdy in view of Allison fails to explicitly teach a system and method, further comprising, when the sending of the message is denied, determining an action to be taken in relation to the message to modify the message by removing a selected type of attachment file into a form in which the sending is allowed.

In an analogous field of endeavor, Dickinson teaches a similar method and system, further comprising, when the sending of the message is denied,

modifying the message by removing a selected type of attachment file before allowing the sending of the message (see p. 3 [0025]).

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to modify Purdy and Allison with the teachings of Dickinson, to include a system and method, further comprising, when the sending of the message is denied, determining an action to be taken in relation to the message to modify the message by removing a selected type of attachment file into a form in which the sending is allowed, in order to prevent virus programs from affecting an intended message recipients computer a taught by Dickinson.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.Claims 4 and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows:

Claim 12 recites ***"a computer program, comprising program code embodied on a computer readable medium...."*** implies a "signal" *modulated/encoded/embodied on a carrier wave/etc.* with functional descriptive material. While functional descriptive material may be claimed as a statutory product (i.e., a "manufacture") when embodied on a tangible computer readable medium, a "signal" per se does not fall within any of the four statutory classes of 35 U.S.C. §101. A "signal" is not a process because it is not a series of steps per se. Furthermore, a "signal" is not a "machine", "composition of matter" or a

"manufacture" because these statutory classes "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." (1 D. Chisum, Patents § 1.02 (1994)). Machines, manufactures and compositions of matter are embodied by physical structures or material, whereas a "signal" has neither a physical structure nor a tangible material. That is, a "signal" is not a "machine" because it has no physical structure, and does not perform any useful, concrete and tangible result. Likewise, a "signal" is not a "composition of matter" because it is not "matter", but rather a form of energy. Finally, a "signal" is not a "manufacture" because all traditional definitions of a "manufacture" have required some form of physical structure, which a claimed signal does not have.

> A "manufacture" is defined as "the production of articles for use from raw materials or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." Diamond v. Chakrabarty, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting American Fruit Growers, Inc. v. Brogdex Co., 283 U.S. 1, 11, 8 USPQ 131, 133 (1931).

Therefore, a "signal" is considered non-statutory because it is a form of energy, in the absence of any physical structure or tangible material, that does not fall within any of the four statutory classes of 35 U.S.C. §101.

NOTE: Refer to Annex IV, section (c) of the USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility", Official Gazette notice of 22 November 2005 (currently at http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McNair, U.S. Patent Number 5,276,444 discloses centralized security control system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony S. Addy whose telephone number is 571-272-7795. The examiner can normally be reached on Mon-Thur 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc M. Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.S.A

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